



THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No.: 40544.00301

In re: Gilchrist, et al.

Serial No.: 09/424,811

Title: Method of Producing Water-Soluble Glass Fibers

Filed: 30 November 1999

Art Unit: 1731

Assistant Commissioner of Patents
Washington, DC 20231

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TC 1700

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**PETITION TO INVOKE
COMMISSIONER'S SUPERVISORY AUTHORITY**

Introduction

This is a petition to invoke the Commissioner's supervisory authority in order to rectify certain errors made by the examiner during the course of prosecution of this application. This petition should be entered and considered on its merits because the petition addresses points that are applicable not only with respect to the pending application, which is the subject of an appeal to the Board of Patent Appeals and Interferences, but also addresses issues which will be of importance with respect to the filing of a continuation or division or continuation-in-part application, all of which are being considered by applicants at this time. Failure to consider this petition on its merits will be highly prejudicial to applicant's subsequent continuation, division or

continuation-in-part patent application in the event such application(s) should mature into United States patent(s) and be enforced against or defended from attack by third parties.

Statement of Facts

The instant application was filed 30 November 1999, disclosing and claiming a method of producing water-soluble glass fibers.

Applicants submitted an Information Disclosure Statement on 23 June 2000, listing five references from the international search report for the PCT application from which this application descends on a Form PTO-1449. Two of the references were English-language abstracts of Japanese patent publications. The Information Disclosure Statement included a short description of the subject matter disclosed in the submitted English-language abstracts of the two Japanese patent publications.

A first official action issued 29 May 2001, rejecting the twenty claims pending in the application as being obvious in light of certain references found by the examiner. Attached to the official action was a photocopy of the Form PTO-1449 submitted by applicants as an attachment to the 23 June 2000 Information Disclosure Statement. On the Form PTO-1449, as signed by the examiner on 5 June 2001 to indicate that the Information Disclosure Statement had been considered, the identifications of the two English-language abstracts of the Japanese patents were struck through with the handwritten notation "No copy of patent".

On 22 June 2001 applicants submitted a Request for Reconsideration of the Information Disclosure Statement. Applicants noted that the Information Disclosure Statement had included a Form PTO-1449 and that two of the references submitted were English-language abstracts of Japanese patent publications, which abstracts had come to

the attention of the applicants as a result of an international search in connection with the Patent Cooperation Treaty patent application on which the instant application was based. Applicants further noted in the 22 June 2001 Request for Reconsideration of the Information Disclosure Statement that the possible relevance of the two English-language abstracts of the Japanese patent publications had been discussed in the original Information Disclosure Statement.

In the 22 June 2001 Request for Reconsideration of the Information Disclosure Statement, applicants went on to note that no English language translation of the full text of either of the Japanese patent publications was readily available and further that it was the understanding of applicant's counsel (subsequently confirmed in communications with the applicants) that copies of the Japanese patent publications were not furnished to the applicants in connection with the international search report and hence were not readily available to applicants. Based on this, applicants requested reconsideration of the Information Disclosure Statement and consideration on the merits of the previously submitted English-language abstracts of the two Japanese patents.

On Thursday, 28 June 2001, applicants' counsel discussed this application and the English-language abstracts of the Japanese patent publications with the examiner. In the course of that conversation the examiner suggested that a new PTO-1449-Modified be submitted, listing the two previously submitted English-language abstracts of the two Japanese patent applications.

On Monday, 2 July 2001, applicants submitted a Supplement to the Request for Reconsideration of the 23 June 2000 Information Disclosure Statement. In accordance with the examiner's suggestion, that Supplement included a PTO-1449-Modified listing

the two English-language abstracts, copies of which had previously been submitted, for the two Japanese patent publications. In the 2 July 2001 Supplement applicants noted that this submission was being made in response to a suggestion made by the examiner during a telephone conversation five days earlier, on 28 June 2001. Applicants again requested consideration on the merits of the two English-language abstracts and that an indication of such action be made in the file by the examiner initialing and returning a photocopy of the PTO-1449-Modified which was enclosed with the Supplement.

On 31 August 2001 applicants submitted an amendment responding to the official action of 29 May 2001. In the amendment applicants amended claim 1, the only independent claim pending in the application, and also amended dependent claim 10. Applicants cancelled claims 9 and 16 through 20 without prejudice. Applicants also argued as to the patentable distinguishability of the claims in their amended form over the references cited by the examiner.

An official action making a final rejection of the application issued 13 September 2001. In the 13 September 2001 official action, the examiner continued to reject all claims pending in the application, repeating verbatim the paragraphs which had appeared in the earlier 29 May 2001 official action rejecting the claims. Additionally, the examiner rejected the newly amended claims under 35 USC 112, contending that there was no support in the specification for the new limitation of maintaining the temperature of the glass working material portion at the working temperature. The examiner went on to state that the 31 August 2001 amendment necessitated a new ground of rejection in the 13 September 2001 official action and, as such, was justification for making rejection of the claims "final".

The 13 September 2001 official action making the rejection final also addressed the two requests for reconsideration of the Information Disclosure Statement, contending that since applicants had represented in the original Information Disclosure Statement that the Japanese patent documents were not readily available "there should be no mention of those Japanese patents on the form PTOL-1449." The 13 September official action further included a gratuitous statement by the examiner that "the Office will not falsely represent to the public... or anyone...that a document was received and considered... if only an abstract was received and considered."

On 12 February 2002, applicants submitted a response to the final office action dated 13 September 2001. In that response, applicants further amended independent claim 1 to specify phosphorus pentoxide as the glass former, placed a lower limit on the dissolution rate of the water-soluble silver ion releasing glass and specified the holding temperature of the molten glass during cooling to be between 400 and 900 degrees Centigrade. Applicants further noted that from the references which had been cited by the examiner, those of ordinary skill in the art had only succeeded in providing glass fibers from silicone dioxide compositions whereas the instant invention provided glass compositions from phosphorus pentoxide.

Applicants further provided a declaration by one of the inventors stating that to the best of the inventor's knowledge, prior to the invention quality water-soluble glass fibers having phosphorus pentoxide as a glass former had not been produced. The inventor declarant further noted that phosphorus pentoxide water-soluble glass making compositions have very, very different properties relative to non-water-soluble glass compositions and that these different properties become manifest during fiber formation.

The declarant further observed that phosphorus pentoxide water-soluble glass compositions according to the invention have much steeper temperature/viscosity gradients than non-water-soluble glass compositions at conventional temperatures for fiber formation, that a small change in temperature can result in a highly significant change in the viscosity of the glass composition according to the invention and further that since water-soluble glass compositions crystallize much more quickly than non-water-soluble glass compositions at suitable temperatures for fiber formation, this limits the lengths of the fibers that can be produced, whereas applicants had surprisingly found that phosphorus pentoxide-based water-soluble glass compositions crystallize in only a very few minutes.

Applicants also submitted a second declaration by an expert in the field of fibers in which the declarant stated that she did not know of any methods of producing phosphorus pentoxide water-soluble glass fiber having a dissolution rate above the lower limit as set by applicants, that she knew water-soluble glass fibers could not be formed by conventional methods and further that the disclosure of the principal reference, cited by the examiner as Gilchrist, was incorrect.

In an advisory action dated 7 March 2002, the examiner noted that the 12 February 2002 amendment after final had not been entered and checked the boxes on the form indicating there was allegedly no convincing showing under 37 CFR 1.116(b) as to why the proposed amendment was necessary and was not earlier presented, the amendments to the claims raised new issues requiring further consideration and/or search and the amendments to the claims were not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal. As to the factual

basis for those assertions, the examiner wrote only that “the new issue is if the amendment would make the claims allowable”. The examiner further noted that upon the filing of an appeal the proposed amendment would not be entered and claims 1-8 and 10-15 would remain rejected.

On 21 March 2002, applicants filed a notice of appeal from the primary examiner to the Board of Patent Appeals and Interferences. The appeal is pending.

Points for Review

1. Did the examiner err in refusing to consider fully on the merits applicant’s 23 June 2000 Information Disclosure Statement and the materials attached thereto, submitted in compliance with 37 CFR 1.97 and 1.98, when the Manual of Patent Examining Procedure states that “Once the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98 are met, the examiner has an obligation to consider the information”?
2. Did the examiner err in again refusing to consider fully applicants’ 23 June 2000 Information Disclosure Statement and the materials attached thereto, in response to applicants’ 22 June 2001 request for reconsideration?
3. Did the examiner err in refusing (for a third time) to fully consider the copy of applicants’ 23 June 2000 Information Disclosure Statement and the accompanying Form PTO-Modified submitted on 2 July 2001, five days after the examiner had suggested making such a submission?

4. Did the examiner err by suggesting, in the 13 September 2001 official action, that applicants had submitted deceptive, erroneous information to the United States Patent and Trademark Office thereby seeking to induce the Office to make false representations to the public, when such suggestion is incorrect, adversely reflects on applicants and their counsel, and may tend to poison the well respecting this application and any continuation, division or continuation-in-part application(s) which may be filed?

5. Did the examiner err in refusing to enter and consider on the merits applicants' response to the final rejection including declaration evidence addressing a new ground of rejection which the examiner raised for the first time in making the rejection final, when the Manual of Patent Examining Procedure states that declarations under 37 CFR 1.132 are timely (and hence must be admitted and considered) if submitted with and to support an initial reply addressing a ground of rejection first presented in a final rejection?

Action Requested

1. Respecting points 1, 2 and 3, applicants seek an order suspending the appeal and remanding the application to the examiner with instructions that the examiner (i) give full consideration on the merits to applicant's 23 June 2000 Information Disclosure Statement, the materials attached thereto and the Form PTO-Modified submitted on 2 July 2001, (ii) apply the non-considered references to applicants' pending claims if the examiner deems those references pertinent (with applicants being given a chance to respond to any new rejection which might result from such consideration by the examiner) and (iii) furnish applicants with a newly-marked copy of the 2 July 2001 Form

PTO-Modified bearing the examiner's initials so the record is clear that all of those materials have been considered in the course of examination of this application.

2 Respecting point 4, applicants seek either direct action by the Commissioner expunging from the file the examiner's statement made in the 13 September 2001 official action suggesting wrongfully that applicants had submitted deceptive and perhaps outright erroneous information to the United States Patent and Trademark Office thereby seeking to induce the Office to make false representations to the public, or remand of the application to the examiner with instructions to the examiner to insert a corrective, curative statement into the file making it clear that applicants and applicants' counsel fully complied with the disclosure requirement under 37 CFR 1.56 and the procedural and substantive requirements of 37 CFR 1.97 and 1.98 and did nothing improper in submitting applicants' information disclosure requirement and the two subsequent requests for full consideration of the same.

3. Respecting point 5, applicants seek an order suspending the appeal and remanding the application to the examiner with directions to enter and consider on the merits applicants' amendment after final rejection and the declaration evidence submitted therewith addressing the ground of rejection the examiner raised for the first time in making the rejection final

Discussion

Respecting the examiner's refusal to enter applicants' amendment after final rejection and the declaration evidence included therewith, MPEP 716.01 clearly indicates

this to have been error on the part of the examiner. By the examiner's own admission, the final rejection of 13 September 2001 set forth a new ground of rejection. Applicants' amendment after final rejection, which was the only paper directed to the merit, if any, of the final rejection, included declaration evidence by two declarants addressing the examiner's contentions newly set forth in the final rejection. In that procedural framework, where only a single paper is submitted subsequent to a final rejection, addressing (necessarily for the first time) a new ground of rejection presented in the final rejection, declarations submitted under 37 CFR 1.132 should be admitted into evidence and considered on their merits.

MPEP 716.01 states that " the following criteria are applicable to all evidence traversing rejections submitted by applicants, including affidavits or declarations submitted under 37 CFR1.132: (A) *timeliness* – affidavits and declarations submitted under 37 CFR 1.132 and other evidence traversing rejections are considered timely if submitted . . . (3) after final rejection and submitted (i) with a first reply after final rejection for the purpose of overcoming a new ground of rejection or requirement made in the final rejection . . . "

It is clear that these declarations not only should have been admitted into evidence by the examiner, they should have been considered on their merits: "Evidence traversing rejections must be considered by the examiner **whenever** present" MPEP 716.01. Declarations and other evidence traversing rejections should be acknowledged and commented on by the examiner in the next succeeding action. No matter whether the evidence is or is not sufficient to overcome the *prima facie* rejection, the examiner is required to submit comments. The comment to be made by the examiner depends on

whether the evidence is sufficient to overcome the *prima facie* basis for rejection of the application. If the evidence is sufficient, the comments are to be consistent with the guidelines for statements of reasons for allowance. Where the evidence is not sufficient, the examiner is required to “specifically explain why the evidence is insufficient” under MPEP 716.01.

In the instant application, the declarations were not even entered much less considered by the examiner. The file history is devoid of any comment by the examiner as to whether those declarations are, or are not, sufficient to overcome the ground of rejection raised by the examiner for the first time in the final rejection of 13 September 2001.

With the MPEP being so explicit as to the lack of discretion on the part of an examiner to refuse to consider such declarations when the examiner has raised an issue for the first time in a final rejection, the examiner’s action in the instant application of refusing to admit, much less consider, applicant’s submission after final rejection is clear error. Applicants are entitled to consideration of these materials by the examiner; for such purpose applicants solicit remand of the application to the examiner for consideration of these materials as set forth in applicants’ action requested above.

Respecting the issues surrounding the Information Disclosure Statement, while there are many shades of gray in the patent law respecting claim interpretation, equivalents infringement and the like, there is nothing gray about the duty of disclosure: Every applicant and every applicant’s counsel has a duty of disclosure respecting all information which is reasonably relevant and material to the examination to the application and to the patentability of the invention under consideration. Indeed, the

Manual of Patent Examining Procedure devotes an entire chapter to the issue of the duty of disclosure, as well as various sections scattered throughout the remainder of the Manual.

The provisions of 37 CFR 1.97 and 37 CFR 1.98 provide a mechanism by which patent applicants may comply with the duty of disclosure established under 37 CFR 1.56.

In the instant application, applicants submitted an Information Disclosure Statement for the purpose of not only fulfilling applicants' duty of disclosure but also to be sure that the United States Patent and Trademark Office had before it and considered all of the information furnished to applicants by the World Intellectual Property Organization in the course of applicants' prosecution of the Patent Cooperation Treaty patent application from which the instant application descends. Part of the international application procedure is the issuance of the international search report. That international search report included two English-language abstracts of two Japanese patent publications. The English-language abstracts were furnished to applicants but the Japanese patent publications were not.

Applicants, in accordance with their duty of disclosure, noted the existence of the English-language abstracts of the Japanese patent publications and submitted copies of the same with the Information Disclosure Statement. All of this was in full accordance with 37 CFR 1.97 and 37 CFR 1.98.

Having done this, applicants were entitled to have the English-language abstracts of the Japanese patent publications considered on their merits as respects the patentability of applicants' invention. Applicants were further entitled to have the examiner's initials placed on the Form PTO-1449 adjacent to the listings of the English-language abstracts

of the Japanese patent publications, in order that the file history would be clear that those English-language abstracts had been considered on their merits respecting patentability of the instant application.

MPEP 609 states that “once the minimum requirements of 37 CFR 1.197 and 37 CFR 1.98 are met, the examiner has an obligation to consider the information.”

The file history clearly evidences that applicants’ Information Disclosure Statement was in full compliance with 37 CFR 1.197 and 37 CFR 1.98. This being the case, applicants are entitled to have the English-language abstracts of the two Japanese patent publications considered on their merits, for whatever effect those English-language abstracts may, or may not, have on the patentability of applicants’ invention. The examiner’s refusal, on three separate occasions, to consider those English-language abstracts on their merits was in direct violation of MPEP 609. Applicants are entitled to and request remand of the application to the examiner for consideration on their merits, whatever those may be, of the English-language abstracts of the Japanese patent publications and to have written indication in the file that the examiner has so-considered those English-language abstracts.

Applicants are also entitled to correction of the file history of the application to remove the examiner’s gratuitous statement that “the Office may not falsely represent to the public . . . or anyone . . . that a document was received and considered . . . if only an abstract was received and considered”. At no time did applicant or applicant’s counsel make any statement in the file wrapper or otherwise that was not 100% factually accurate. For the examiner to gratuitously make the statement quoted above reflects wrongly on applicants and on applicants’ counsel and may effectively poison the well

respecting the file history of the instant application, as well as any subsequent continuation, division or continuation-in part application which may be filed seeking patent protection for the subject matter of the instant application and the invention disclosed therein by raising an unjustified inference of unclean hands on the part of applicants.

The Manual of Patent Examining Procedure in section 609 addresses the appropriate procedure for an examiner to follow if an information disclosure statement fails to comport with the requirements of 37 CFR 1.197 and 37 CFR 1.98. Section 609 of the MPEP also includes form paragraphs for an examiner to use in the event the examiner believes a particular information disclosure statement fails to meet the requirements of 37 CFR 1.197 and 37 CFR 1.98. Those form paragraphs are set forth as paragraphs 6.49 through 6.49.09, on pages 600-130 and 600-131 in the most recent edition of chapter 600 of the Manual of Patent Examining Procedure. Applicants are unable to find any statement of the type made by the examiner in this collection of permissible statements. Applicants are entitled to expungement of the examiner's statement from the file.


Applicants respectfully submit that it takes little in the way of imagination to envision a skillful advocate lifting the examiner's statement from the file wrapper in a courtroom and using that statement with devastating effect in closing argument in a trial involving patent infringement. In order for applicants to have a level playing ground, in the event applicants are successful in securing patent protection growing out of this application and subsequently seek to assert, or need to defend, the patent vis-a-vis a third party, expungement of the examiner's gratuitous statement from the file is necessary.

Conclusion

This Petition should be granted in all respects.

Respectfully submitted,

Dated: 23 Jun 2002


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Carolyn Waters